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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,789	04/05/2001	Masanori Suzuki	64753 CCD	4081

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EXAMINER

NOTE, JANIS L

ART UNIT

PAPER NUMBER

1756

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/826,789

Applicant(s)

SUZUKI ET AL.

Examiner

Janis L. Dote

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires ~ 8 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 10 April 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): see the attached, paragraph 2.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 8, 21, 30 and 39.
Claim(s) objected to: _____.
Claim(s) rejected: 1-6, 9-19, 22, 32-37 and 40.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see the attached, paragraph 3.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

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1700

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1. For purposes of appeal, the proposed amendment filed on Apr. 10, 2006, will be entered upon the filing of the appeal brief and the proposed rejection(s) detailed below will be included in the Examiner's Answer. To be complete, such rejection(s) must be addressed in any brief on appeal.

Upon entry of the amendment(s) for purposes of appeal: Claims 1-6, 9-19, 22, 32-37, and 40 would be rejected for the reasons set forth in paragraphs 9-12 of the final Office action mailed Oct. 13, 2005.

Paragraph 9:

Claims 1-3, 5, 6, 32-34, 36, and 37 would be rejected under 35 U.S.C. 103(a) over US 5,733,699 (Asanae'699) combined with European Patent 0936507 A2 (EP'507) for the reasons discussed in paragraph 9 of the final Office action, except for the concluding paragraph, which would include a discussion of obtaining a two-component developer that has properties disclosed by Asanae'699 and that provides high quality black toned images as taught by EP'507. This change is necessitated by amendment to claim 1 filed on Apr. 10, 2006, which deleted the toner saturation magnetization limitation from the subject matter recited in said claim.

Paragraph 10:

Claims 4 and 35 would be rejected under 35 U.S.C. 103(a)

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over Asanae'699 combined with EP'507, as applied to claims 1 and 32 above, further combined with additional teachings in Asanae'699 and EP'507, for the reasons discussed in paragraph 10 of the final Office action, except for the concluding paragraph, which would include a discussion of obtaining a two-component developer that has properties disclosed by Asanae'699 and that provides high quality black toned images as taught by EP'507. This change is necessitated by amendment to claim 1, from which claim 4 depends, filed on Apr. 10, 2006, which deleted the toner saturation magnetization limitation from the subject matter recited in claim 1.

Paragraph 11:

Claims 9 and 40 would be rejected under 35 U.S.C. 103(a) over Asanae'699 combined with EP'507, as applied to claims 1 and 32 above, further combined with US 5,866,289 (Asanae'289), for the reasons discussed in paragraph 11 of the final Office action, except for the concluding paragraph, which would include a discussion of obtaining a two-component developer that has the benefits disclosed by Asanae'699 and that provides black toned images with improved resolution as taught by Asanae'289. This change is necessitated by amendment to claim 1, from which claim 9 depends, filed on Apr. 10, 2006, which deleted the toner saturation magnetization limitation from the subject matter

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recited in claim 1.

Paragraph 12:

Claims 10-16, 18, and 19 would be rejected under 35 U.S.C. 103(a) over Asanae'699 combined with EP'507 and US 5,771,426 (Oka).

Claim 17 would be rejected under 35 U.S.C. 103(a) over Asanae'699 combined with EP'507 and Oka.

Claim 22 would be rejected under 35 U.S.C. 103(a) over Asanae'699 combined with EP'507, Asanae'289, and Oka.

The claims would be rejected for the reasons discussed in paragraph 12 of the final Office action.

2. The objection to the specification under 35 U.S.C. 132, set forth in the final Office action mailed on Oct. 13, 2005, paragraph 4, would be withdrawn in response to the deletion of the paragraph inserted at page 56, between lines 5 and 6, of the specification, in the amendment filed on Sep. 26, 2003, set forth in the amendment filed on Apr. 10, 2006, which will be entered upon the filing of an appeal brief.

The rejections under 35 U.S.C. 103(a) of claims 1-6 and 38 under 35 U.S.C. 103(a) over Asanae'699 combined with EP'507, and of claims 9 and 20 over Asanae'699 combined with EP'507 and the other cited references, set forth in the final Office action

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mailed on Oct. 13, 2005, paragraphs 13-16, would be withdrawn in response to the amendment to claim 1 and the cancellation of claims 20 and 38 set forth in the amendment filed on Apr. 10, 2006, which will be entered upon the filing of an appeal. That amendment to claim 1 and the cancellation of claims 20 and 38 removed the toner saturation magnetization limitation recited in those claims.

3. Applicants' arguments set forth in the amendment filed after the final rejection on Apr. 10, 2006, are not persuasive to the overcome the rejections of over Asanae'699 combined with EP'507 or the rejections over Asanae'699 combined with EP'507 and the other cited prior art for the reasons of record. (The examiner reminds applicants that the published application US 2003/0036010 A1 is not part of the instant application. In further prosecution, especially in the filing of an appeal brief, when applicants reference the disclosure in the instant specification, applicants must refer to the substitute specification filed on Nov. 12, 2002, by page and line number.)

In addition, the reasons for combining the references do not have to be those of applicants. For the reasons discussed in the final rejection, the combined teachings of the cited prior art render prima facie obvious the two-component developer

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the method of forming an image, and the image formation apparatus recited in the claims presented in the amendment filed the final rejection.

For the first time, applicants assert that the showing in the instant specification, in particular examples 1 and 7 and comparative examples 1-4, demonstrates that the two-component developer toner as recited in proposed-amended claim 1 set forth in the amendment filed after the final rejection provides unexpected results over the prior art.

However, the showing in the instant specification is insufficient to overcome the rejections over the prior art for the following reasons:

(1) The showing in the instant specification, namely examples 1 and 7, is not commensurate in scope with the proposed-amended claim 1 or with independent claims 10, 13, and 32. Examples 1 and 7 exemplify preferred two-component developers comprising preferred toners, which comprise preferred amounts of less than 6 wt% or less of carbon black based on the weight of the toner (see claims 5, 18, and 36). The preferred toners also have a preferred toner volume mean diameter of 9.0 μm (see claims 9, 22, and 40). The preferred toners also comprise a preferred magnetic material that is blackened with a preferred pigment, i.e., carbon black (see claims 3, 12, 16,

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and 34) and that has a preferred average particle diameter of 0.23 μm (see instant claims 6, 19, and 37). The preferred magnetic material is present in preferred amounts of 21.9 wt% or 18.8 wt% based on the weight of the toner (see claims 4, 14, 17, and 35). In addition, the toner in example 7 comprises a preferred polyester resin (see claims 8, 21, 30, and 39). There is no evidence that the full scopes of the proposed-amended claim 1 and independent claims 10, 13, and 32 yield unexpected results over the prior art. Instant examples 1 and 7 comprise combinations of preferred embodiments that are recited individually in claims 3-6, 9, 12, 14, 16-19, 22, 34-37, and 40, which depend from proposed-amended claim 1 and independent claims 10, 13, and 32, respectively, and of claims 8, 21, 30, and 39. No claim is limited to the combination of preferred embodiments shown in the examples.

In addition, independent claims 10 and 13 do not limit the amount of the blackened magnetic material to any amount, let alone the amount range of 10 wt% to 40 wt% based on the weight of the toner. Applicants have not shown that any of the argued advantages are obtainable from amounts outside the preferred range of 10 to 30 wt% or the range of 10 to 40 wt% recited in proposed-amended claim 1 and independent claim 32, based on the weight of the toner, commensurate with the full scopes of

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instant claims 10 and 13.

Given the welter of unconstrained variables, it is not clear whether the results reported in the instant specification are due to the toner having the particular blackened magnetic material recited in proposed-amended claim 1 and independent claims 10, 13, and 32, as asserted by applicants, or due to some combination of the preferred embodiments.

Moreover, applicants have not shown that the full amount range of 10 to 40 wt% based on the weight of the toner of the blackened magnetic material recited in proposed-amended claims 1 and independent claim 32 is critical. As discussed above, examples 1 and 7 exemplify the amounts of 21.9 wt% and 18.8 wt%, respectively. The instant specification does not exemplify toners comprising the blackened magnetic material in amounts of 10 wt% or 40 wt%, the lower and upper limits, respectively, of the amount range of 10 to 40 wt%, based on the weight of the toner, as recited in proposed-amended claim 1 and independent claim 32. The limited showing in examples 1 and 7 does not exemplify the full scope of the amount range of the blackened magnetic material recited in those claims. Nor does the limited showing establish that the amount range of 10 to 40 wt% is critical as alleged by applicants. Accordingly, applicants' showing is not commensurate with the scope of the exclusion

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protection they seek.

Thus, given the welter of unconstrained variables and the limited showings in examples 1 and 7 of the instant specification, applicants have not satisfied their burden to show that the full scopes of proposed-amended claim 1 and independent claims 10, 13, and 32 provide unexpected results over the prior art.

(2) Furthermore, the toner recited in proposed-amended claim 1 and independent claims 10, 13, and 32 do not appear to provide unexpected results. Comparative examples 1 and 4 exemplify two-component developers as exemplified in examples 1 and 7, respectively, except that the toner comprises a magnetic material not blackened by carbon black. Example 9 comprises a two-component developer as exemplified in example 7, except that carbon black is present in amount of 8 wt% based on the weight of the toner. The two-component developer in example 9 is within the magnetic material limitations recited in proposed-amended claim 1 and independent claims 10, 13, and 32. However, the two-component developer in comparative example 1 provides better results in "fogging" and "evenness in image density" than the two-component toner in example 9, and results in "uniformity in solid image," "reproducibility of thin line," "image-fixing," and "anti-hot-offset" similar to the two-component toner in

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example 9. The two-component developer in comparative example 4 provides better results in "fogging" than the two-component toner in example 9, results in "evenness in image density," "reproducibility of thin line," "image-fixing," and "anti-hot-offset" similar to the two-component toner in example 9, and results in "uniformity in solid image" slightly poorer than the two-component developer in example 9.

In addition, comparative examples 2 and 3, which exemplify two-component developers as exemplified in example 1, except that the amounts of the carbon black blackened magnetic material are 5 wt% and 50 wt%, respectively, based on the weight of the toner. Comparative examples 2 and 3 are within the two-component developer limitations recited in instant claims 10 and 13, but not within the two-component developer limitations recited in proposed-amended claim 1 and independent claim 32. As discussed supra, the two-component developer in example 9 meets the two-component developer limitations recited in proposed-amended claim 1 and independent claims 10, 13, and 32. However, the two-component developer in comparative example 2 provides better results in "uniformity in solid image" than the two-component toner in example 9 and results in "fogging," "evenness in image density," "reproducibility of thin line," "image-fixing," and "anti-hot-offset" similar to the two-

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component toner in example 9. The two-component developer in comparative example 3 provides better results in "fogging" than the two-component toner in example 9, results in "evenness in image density," "reproducibility of thin line," "image-fixing," and "anti-hot-offset" similar to the two-component toner in example 9, and results in "uniformity in solid image" slightly poorer than the two-component developer in example 9.

Thus, the results shown in the instant specification for two-component developers labeled of the invention do not appear to be unexpected over the two-component developers in comparative examples 1-4 as asserted by applicants.

(4) The showing in the instant specification, namely comparative examples 1-4, does not appear to compare to the closest prior art. Asanae'699 teaches a two-component developer comprising a magnetic carrier having a volume resistivity of $10 \Omega \cdot \text{cm}$ or greater and less than $10^6 \Omega \cdot \text{cm}$ and a magnetic toner comprising a binder resin and magnetic powder and having a volume resistivity of not less than $10^{13} \Omega \cdot \text{cm}$, where the weight ratio of the magnetic carrier and magnetic toner is between 10:90 to 90:10. See Asanae'699, col. 2, lines 25-29. The magnetic carrier and magnetic toner having the particular volume resistivities are critical elements of the invention of Asanae'699. See Asanae'669, col. 2, lines 15-38. Asanae'699

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teaches the disadvantages of not using its magnetic carrier with its magnetic toner. See col. 3, lines 25-37, and col. 6, line 62, to col. 7, line 4. Proposed-amended claim 1 and independent claims 10, 13, and 32 do not exclude the magnetic carrier from having the particular volume resistivity required by Asanase'669. Nor do the claims exclude the toner from having the volume resistivity required by Asanae'669. The instant specification does not disclose the volume resistivities of the magnetic carriers and toners exemplified in comparative examples 1-4. Thus, comparative examples 1-4 do not appear to be probative comparisons to the closest prior art.

Because the showing in the instant specification does not appear to provide a probative comparison to Asanae'699, applicants have failed to show that the two-component developers recited in proposed-amended claim 1 and independent claims 10, 13, and 32 provide unexpected results over the prior art.

Accordingly, the rejections over the prior art stand.